

### REMARKS

Claims 1-8, 16 and 18-28 are pending in the application. Claims 9-15 and 17 were previously cancelled. Claims 1 and 16 are amended to more particularly claim Applicants' invention. Claims 21-28 are previously added. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

#### *Claim Rejections – 35 USC § 102*

The Patent Office rejected claims 1, 3-5 and 8, under 35 U.S.C. § 102(e) as being anticipated by Strandwitz et al. (U.S. Patent No. 6,522,352). Claim 1 has been amended to more particularly claim Applicants' invention. Applicants respectfully traverse the rejections of claims 1, 3-5 and 8.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. MPEP § 2131; *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." MPEP § 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

With respect to claims 1, 3-5 and 8, Strandwitz et al. fails to disclose, teach or suggest a method for communicating and recording an image to a removable media device comprising the steps of "storing the communicated image in memory on the removable media device; thereafter reformatting the stored image; and recording the reformatted image on removable media of the removable media device," as presently recited in claim 1. Instead, Strandwitz et al. teaches a system wherein the captured image is processed internally by the image capture device *prior* to transmission. Nowhere does the Strandwitz et al. reference specifically disclose that the image may be transmitted to the removable media device, and *once there*, be stored in memory, *then* be reformatted, and *finally* saved to removable media of the removable media device.

The Patent Office equates the video camera 10 disclosed by Strandwitz et al as to the image capture device claimed by Applicant. Likewise, the Patent Office equates the Strandwitz et al. base station 20 with Applicants' removable media device. The Patent Office then asserts that column 4, lines 32-48 of Strandwitz et al. discloses the step of "thereafter, reformatting the *stored* image" recited in claim 1. Column 4, lines 32-48 of Strandwitz et al., which describes FIG. 2, provides that the Strandwitz et al.

[v]ideo encoding/decoding module 200 and real time video transport protocol module 230 can together be viewed as first video processing and video reconstruction circuitry that provide to the transceiver 100 selectively processed first video signals processed according to a selected protocol scheme and provide reconstructed second video signals to the monitor 140. Similarly, video encoding/decoding module 200 and verified video transport protocol module 240 can together be viewed as second video processing and video reconstruction circuitry that provide to the transceiver 100 selectively processed first video signals processed according to a different selected protocol scheme and provide reconstructed second video signals to the monitor 140. Similarly, reliable still image encoding/decoding module 210 and reliable still image transport protocol module 250 can together be viewed as third video processing and video reconstruction circuitry.

Thus, the encoding/decoding performed by the Strandwitz et al. system is accomplished by components within the video camera 10 (i.e., the encoding/decoding module 200 and the video transport protocol module 230), not the base station 20. Consequently, encoding/decoding of the "video signals" is done prior to transmission of the video signal to the base station 20. Thus, Strandwitz et al. nowhere discloses, teaches or suggests the step of reformatting the image after the image is both transmitted to the removable media device by the image capture device and stored to memory by the removable media device as recited in claim 1. Accordingly, it is respectfully submitted that *prima facie* anticipation of claims 1, 3-5 and 8 has not been established under MPEP § 2131. Withdrawal of the rejections of claims 1, 3-5 and 8 is therefore respectfully requested.

*Claim Rejections – 35 USC § 103*

The Patent Office rejected claims 16, 18, 20, 25, 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Strandwitz et al. (U.S. Patent No. 6,522,352) in view of Roberts et al. (U.S. Patent No. 6,649,622). The Patent Office also rejected claims 2, 6, 7 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Strandwitz et al. in view of Squilla et al. (U.S. Patent No. 6,396,537). Finally, the Patent Office also rejected claims 19 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Strandwitz et al. in view of Roberts et al. and Squilla et al. Claim 16 has been amended to more particularly claim Applicants' invention. Applicants respectfully traverse the rejections of claims 2, 6, 7, 16, 18, 19, 20, 22, 25, 26, 27, 28 and 29.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 citing *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Moreover, when applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. See MPEP § 2141 and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

With respect to claims 16, 18, 20, 25, 26 and 28, Strandwitz et al. fails to teach or suggest "querying the image storage device for a supported format; and if the supported format differs from an image format, reformatting the image to the supported format without user intervention and communicating the image from the image capture device to the image storage device" as claimed in independent claim 16, or an image capture device for capturing the image, . . . wherein the image capture device . . . queries the image storage device for a supported format; deciphers the image to the supported format if the supported format differs from the image format, and communicates the image to the image

storage device for storage to the removable media as claimed in independent claim 25.

Roberts et al. fails to make up for this defect in the teaching of Strandwitz et al. since Roberts et al. requires user intervention to set the correct format. Specifically, Roberts et al. teaches that

if the format does not match or if the disk 50 is unformatted, the disk format status light emitting diode 23 would be illuminated and an appropriate error display would be illuminated in the status display 22 *thus prompting the user to take appropriate corrective measures*

Roberts et al., column 8, lines 60-65. Moreover, there exists no teaching or motivation for modifying the teachings of Strandwitz et al or Roberts et al. to provide this feature of Applicants' invention.

Claims 2, 6, 7, 19, 22 and 27 depend from claims 1, 16, 21 or 25. As noted above, neither Strandwitz et al. nor Strandwitz et al in combination with Robert et al. discloses, teaches or suggests a method for communicating and recording an image to a removable media device comprising the steps of "storing the communicated image in memory on the removable media device; thereafter deciphering the stored image; and recording the deciphered image on removable media of the removable media device," as presently recited in claim 1, a method for communicating and formatting an image from an image capture device, comprising "initiating a wireless connection between an image capture device and an image storage device; querying the image storage device for a supported format; and if the supported format differs from an image format, reformatting the image to the supported format without user intervention and communicating the image from the image capture device to the image storage device," as presently recited in claim 16, or an image capture device for capturing the image, . . . wherein the image capture device . . . queries the image storage device for a supported format; decipheres the image to the supported format if the supported format differs from the image format, and communicates the image to the image storage device for storage to the removable media as claimed in independent claim 25. Squilla et al. fails to make up for this defect in the Strandwitz et al. and Roberts et al. references since Squilla et al. is relied on only to

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teach a removable media device including at least one of a digital versatile disk (DVD), digital video disk-erasable (DVD-e), VCD, and compact disc. Moreover, there exists no suggestion or motivation from the prior art to modify Strandwitz et al. Roberts et al. or Squilla et al. to achieve Applicants' invention as claimed.

Accordingly, it is respectfully submitted none of Strandwitz et al., Roberts et al. and Squilla et al., either alone or in combination fail to disclose teach or suggest Applicants' invention as claimed in claims 2, 6, 7, 16, 18, 19, 20, 22, 25, 26, 27, 28 and 29. Withdrawal of the rejections of claims these claims under 35 U.S.C. § 103(a) is therefore respectfully requested.

*Rejection of Claims 21, 23 and 24*

The Patent Office did not set forth specific reasons for the rejections of claims 21, 23 and 24 as required by M.P.E.P. §707.07(g). Consequently, Applicants are unable to respond to the rejections of these claims. However, Applicants submit that claims 21, 23 and 24 are patentable over the cited references for at least the reasons set forth above.

**CONCLUSION**

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

Respectfully submitted,  
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